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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,124	04/20/2007	Klaus Kulper	101769-370 KGB	4140
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EXAMINER				
HUANG, CHENG YUAN				
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1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/590,124

**Applicant(s)**

KULPER ET AL.

**Examiner**

CHENG HUANG

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)  
Paper No(s)/Mail Date 20060818
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to a tape.

Group II, claim(s) 9-10, drawn to a method of using a tape.

Group III, claim(s) 11-12, drawn to an elongate product.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature that is commonly shared between the inventions of Group I, II, and III of a tape is taught by Boettcher (DE 10107569) who teaches a highly abrasion-resistant and noise-suppressing tape for bandaging cable harnesses (See Title), particularly in automobiles (vehicles, paragraph [0001]), comprising a backing with a first outer layer A (vertical pile fibers (3), Abstract, lines 1-3), which is firmly connected to a second layer C (fibrous mesh surface (2), Abstract, line 2) over the entire area of outer layer A (See Figs. 1 and 2), the outer layer A is composed of a formed-loop knit (See fig. 1), the layer C being composed of a porous sheetlike structure (fibrous mesh surface (2), Abstract, line 2). Given that Boettcher teaches the claimed invention, the cited claims fail to define a contribution over the prior art. Therefore, the cited claims fail to constitute a special technical feature and hence lack of unity exists between the cited claims.

3. During a telephone conversation with Kurt G. Briscoe on 26 August 2009 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-12 are

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

6. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be

amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The term "highly" in claim 1 is a relative term which renders the claim indefinite. The term "highly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear to what extent the tape is abrasion-resistant and noise-suppressing.

10. The term "firmly" in claim 1 is a relative term which renders the claim indefinite. The term "firmly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear to what extent the first outer layer A is connected to second layer C.

11. Claims 1 and 6 are unclear given that it is not clear what is meant by the phrase “sheetlike” or what is considered “like” a sheet.
12. Claims 6 and 7 recite second outer layer B that is not found in the claim upon which they depend, which is claim 1. For the purposes of examination, claims 6 and 7 are considered to depend upon claim 2.

*Claim Rejections - 35 USC § 102*

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Boettcher (DE 10107569).
15. Regarding claim 1, Boettcher teaches a highly abrasion-resistant tape for bandaging cable harnesses (See Title), particularly in automobiles (vehicles, paragraph [0001]), comprising a backing with a first outer layer A (vertical pile fibers (3), Abstract, lines 1-3), which is firmly connected to a second layer C (fibrous mesh surface (2), Abstract, line 2) over the entire area of outer layer A (See Figs. 1 and 2), the outer layer A is composed of a formed-loop knit (See fig. 1), the layer C being composed of a porous sheetlike structure (fibrous mesh surface (2), Abstract, line 2).
16. Regarding the limitation “a highly abrasion-resistant and noise-suppressing tape for bandaging cable harnesses,” applicants attention is drawn to MPEP 2111.02 which states that “if

the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

17. It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. a highly abrasion-resistant and noise-suppressing tape for bandaging cable harnesses, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art invention. The prior art structure, which is identical to that set forth in the present claims, is capable of performing the recited purpose or intended use. Furthermore, the claimed limitation is taught by Boettcher, as disclosed above.

18. Regarding claim 4, Boettcher teaches a tape (See Title) wherein preferred examples disclose layer C having a basis weight of 220 g/m<sup>2</sup> or 350 g/m<sup>2</sup> (See Tables), which fall within the claimed ranges of 100 to 500 g/m<sup>2</sup>.

19. Regarding claim 6, the claimed limitation is a process limitation. It is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its

method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

20. Therefore, absent evidence of criticality regarding the presently claimed process and given that Boettcher meets the requirements of the claimed tape, Boettcher clearly meets the requirements of present claims.

21. Claims 1, 3, 5, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by DeCoste, Jr. et al. (U.S. Patent No. 4,705,715).

22. Regarding claim 1, DeCoste, Jr. et al. teaches a tape (See Title) comprising a backing with a first outer layer A (scrim 12, col. 4, lines 28-29), which is firmly connected to a second layer C (foam 14, col. 4, lines 27-28) over the entire area of outer layer A (See Figs. 1 and 2), the outer layer A being composed of a scrim (scrim 12, col. 4, lines 28-29), and the layer C being composed of a foam (foam 14, col. 4, lines 27-28). The scrim of DeCoste, Jr. et al. is considered an “outer” layer since it is outer to at least one layer (e.g., adhesive layer 18, col. 4, line 36, Fig. 2)

23. While there is no disclosure that the tape of DeCoste, Jr. et al. is a highly abrasion-resistant and noise-suppressing tape for bandaging cable harnesses as presently claimed,



applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

24. It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. a highly abrasion-resistant and noise-suppressing tape for bandaging cable harnesses, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art tape and further that the prior art structure which is identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

25. Regarding claim 3, while DeCoste, Jr. et al. does not explicitly disclose the claimed limitation of abrasion resistance of the backing, the claimed values are inherent in the backing of DeCoste, Jr. et al. since the prior art teaches materials identical (polyethylene or polypropylene, col. 4, lines 42-44) to those of the presently claimed invention (polyolefins, paragraph [0048], Applicant’s US-PGPUG).

26. Regarding claim 5, DeCoste, Jr. et al. teaches a tape (See Title) wherein a foam layer has a thickness of 8 mils, or 0.203 mm (col. 4, lines 39-41), which falls within the claimed range of 0.2 to 3 mm.

27. Regarding claim 6, the claimed limitation is a process limitation. It is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

28. Therefore, absent evidence of criticality regarding the presently claimed process and given that DeCoste, Jr. et al. meets the requirements of the claimed tape, DeCoste, Jr. et al. clearly meets the requirements of present claims.

29. Regarding claim 8, DeCoste, Jr. et al. teaches a tape (See Title) wherein the backing is coated at least on one side with a self-adhesive compound (adhesive layer 18, col. 4, line 52, Fig. 2) and the self-adhesive compound is a rubber adhesive (col. 3, lines 46-48).

***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

32. Claims 2, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boettcher (DE 10107569) in view of DeCoste, Jr. et al. (U.S. Patent No. 4,705,715).

33. Boettcher is relied upon as disclosed above.

34. Regarding claim 2, Boettcher fails to teach a second outer layer B.

35. However, DeCoste, Jr. et al. teaches a tape (See Title) comprising a backing with a first outer layer A being composed of a scrim or woven fabric (scrim or cloth web 12, col. 3, lines 56-57, col. 4, lines 28-29), and a second layer C being composed of a foam (foam 14, col. 4, lines 27-28).

36. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a second outer layer A being composed of a woven cloth web on an open side of layer C of Boettcher for easy tearability in the cross direction (DeCoste, Jr. et al., col. 3, lines 56-58).

37. Regarding claim 5, while Boettcher teaches a tape (See Title) wherein layer C has a thickness of 4.2 mm (See Table 1), this is only a preferred example and it would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thickness of layer C, such decreasing of the thickness for reducing the bulk of the tape during application.

38. Alternatively, DeCoste, Jr. et al. teaches a tape (See Title) wherein a foam layer has a thickness of 8 mils, or 0.203 mm (col. 4, lines 39-41), which falls within the claimed range of 0.2 to 3 mm.

39. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose a thickness for layer C of Boettcher for reducing the bulk of the tape during application.

40. Regarding claim 8, Boettcher teaches a tape (See Title) wherein the backing is coated at least on one side with a self-adhesive compound (adhesive layer 10 or 6, Abstract, line 4, paragraph [0015]).

41. Boettcher fails to teach the self-adhesive compound being of a rubber or acrylate or silicone adhesive.

42. However, DeCoste, Jr. et al. teaches a tape (See Title) wherein the backing is coated at least on one side with a self-adhesive compound (adhesive layer 18, col. 4, line 52, Fig. 2) and the self-adhesive compound is a rubber adhesive (col. 3, lines 46-48).

43. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a rubber adhesive for the adhesive of Boettcher for ease of application by the user (col. 3, lines 44-46).

44. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCoste, Jr. et al. (U.S. Patent No. 4,705,715).
45. DeCoste, Jr. is relied upon as disclosed above.
46. Regarding claim 2, while DeCoste, Jr. et al. fails to explicitly disclose a second outer layer, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a second outer layer A being composed of a woven cloth web on an open side of layer C for easy tearability in the cross direction (col. 3, lines 56-58). The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second outer layer being composed of woven fabric would have achieved expected results such as easy tearability in the cross direction. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. *In re Harza*, 124 USPQ 378, 380 (CCPA 1960).
47. Regarding claim 7, DeCoste, Jr. et al. teaches a tape (See Title) wherein layer C comprises wear-resistant polymers (polyethylene or polypropylene, col. 4, lines 42-44). It is understood that layers A and B of the tape of DeCoste, Jr. et al. comprise wear-resistant polymers given that any known web materials may be used (col. 4, lines 47-50), including natural or synthetic fibers (col. 4, lines 49-51), which are intrinsically wear-resistant.

### ***Conclusion***

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1794

September 11, 2009

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794